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Via Federal Express

December 5, 2011

The Honorable F. Dennis Saylor, IV
United States District Judge
United States District Court
Donohue Federal Building
595 Main Street
Worcester, MA 01608

Re: *Abbott GmbH & Co., KG et al. v. Centocor Ortho Biotech, Inc. et al.*, C.A. No. 4:09-cv-11340

Dear Judge Saylor:

I am writing to respond to Ms. Elderkin's letter to you dated December 1, 2011 concerning *Teva Pharmaceutical Industries Ltd. v. AstraZeneca Pharmaceuticals LP et al.*, No. 2011-1091 (Fed. Cir. Dec. 1, 2011).

The *Teva* decision bears on the issue of what Centocor must show to demonstrate a prior date of invention. Centocor contends that it is required to prove only that its inventors appreciated that they had isolated an antibody that neutralizes IL-12. Abbott contends that Centocor's inventors also needed to appreciate that the antibody had other features required by the claims (for example, the affinity limitations found in the claims of the '128 patent).

The *Teva* decision confirms that this "appreciation" requirement does not require an inventor to have appreciated the invention in the same words as the claim or the specific manner by which the invention works. However, nothing in the *Teva* decision suggests that the limitations of the claims and their scope can be disregarded in determining whether the putative inventor "appreciated what it had made." *Teva*, slip op. at 11; *see Invitrogen Corp. v. Clontech Labs Inc.*, 429 F.3d 1052, 1065-66 (Fed. Cir. 2005) (to demonstrate prior invention, a party must show "that persons skilled in the art at the time of the recognition would have ***recognized the existence of the relevant inventive features***") (emphasis added); *Cooper v. Goldfarb,* 240 F.3d 1378, 1384 (Fed. Cir. 2001) (alleged prior inventor required to demonstrate that "he knew, at the time of his alleged reduction to practice, both that ***the material had the properties recited in the count*** and that it would be useful as a graft") (emphasis added). Thus, while the inventors in the *Teva* case were not required to demonstrate what ingredient in their formulation was the source of improved stability, they were required to demonstrate that they appreciated the fact of improved stability as required by the claims. Analogously, to demonstrate prior invention of the '128 patent claims, Centocor needs to show at least that it recognized that its antibody had the affinity properties of the claims, even if Centocor is not required to demonstrate an

understanding of the characteristics of the antibody responsible for those properties (*e.g.*, the antibody's epitope).

Respectfully yours,

William G. McElwain

cc: Dianne B. Elderkin (via email)
Barbara L. Mullin (via email)